

Application No.: 10/613,249

Case No.: 58817US002

REMARKS

Claims 1 to 64 are pending. Claims 20, 24, 28, 42, 50, and 62 are currently amended.

Support for the amendment to claims 20, 24, 28, 42, 50, and 62 may be found, for example, the respective original claims.

§ 112 Rejections

Claims 12-15, 18-20, 24, 28, 42, 50 and 62 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

More particularly, the Patent Office asserts that in claims 12-15, 18 and 19 the term "auxiliary adhesive" is a term unfamiliar to the Examiner, does not appear to be defined by Applicants' specification and as such is considered vague, indefinite and confusing.

The Patent Office asserts that in claims 20 and 42 proper Markush language should be utilized; and that in claims 24 and 62 the term "other monomers" is vague and indefinite, as is "is at least" in claims 28 and 50.

Regarding to the term "auxiliary adhesive", the Examiner's attention is drawn to the specification, for example, on page 18, lines 14-18, wherein the meaning of the term is discussed in detail. Reconsideration and withdrawal of the rejection is respectfully requested.

Without agreeing that amendment is necessary for patentability, but in earnest effort to facilitate prosecution, claims 20, 28, 42, and 50 have been amended as suggested by the Examiner.

Without agreeing that the term "other monomers" is indefinite, but again in earnest effort to facilitate prosecution, claims 24 and 62 have been amended as suggested by the Examiner.

In view of the above, it is submitted that the rejection of claims 12-15, 18-20, 24, 28, 42, 50 and 62 under 35 U.S.C. § 112, second paragraph, has been overcome and should be withdrawn.

Application No.: 10/613,249

Case No.: 58817US002

§ 103 Rejections

Claims 1-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admissions in the specification at page 8, line 26 - page 9 line 2 concerning each of the three references Shiba et al., Lawton and WO 96/08540, the admissions taken in view of the remaining corresponding disclosure of each of the three references.

More particularly, the Patent Office asserts Applicants admit in their specification that each of these three references discloses "useful heat activatable adhesives", while each of the references further discloses (note particularly Shiba et al., column 1, lines 12-18, column 6 line 57 - column 7 line 12, column 7 lines 23-35, the Examples; Lawton, the Abstract, column 1 lines 5-37, column 17 lines 20-22, lines 32-39, column 18 lines 52-68, column 20 lines 10-14; WO - 540, page 3, second paragraph, pages 4-5 bridging paragraph, claim 1) a broad genus of heat activatable adhesives coated onto suitable film substrates to form a genus of what are inherently believed to define "cling articles", wherein the formed articles each feature an adhesive layer which Applicants admit is suitable, with the substrate coated thereon being a film which is believed to, if not expressly or inherently disclose the subject matter of the genus of films set forth in, e.g. claim 24, be at most an obvious modification to one of ordinary skill.

The Patent Office further asserts that the gel content of the adhesive is also believed to be, if not expressly or inherently disclosed, an obvious modification based upon the amount of cross-linking desired with respect to the dependent claims, the particular activation temperatures of the adhesive are believed to be obvious optimizations well within the ordinary skill of the art, as is the presence of an electret film, and continuous or discontinuous adhesive layers are all believed to be parameters well within the ordinary skill of the art, in the absence of unexpected results.

Without agreeing to the Patent Office's characterization of Applicants' alleged admissions in the specification at page 8, line 26 - page 9 line 2 concerning each of Shiba et al., Lawton and WO 96/08540 in view of the remaining corresponding disclosure of each of the three references, Applicants submit that the mere presence of a heat-activatable adhesive on a substrate is insufficient to achieve the invention of instant claims 1, 29, and 53. For example, it is unclear how Shiba et al., Lawton or WO 96/08540 provides "a cling backing having first and second

Application No.: 10/613,249

Case No.: 58817US002

opposed major surfaces; and a heat-activatable adhesive in contact with at least a portion of the first major surface", for example, as in instant claims 1, 29, and 53.

The term "cling backing" is defined in the specification, for example, on page 5, lines 11-12 as "a backing that can cling to a substrate without the use of adhesives or fasteners. Examples of cling backings are described in the specification, for example, from page 5, line 21 through page 6, line 19. They include, for example, cling vinyl (e.g., see page 5, lines 30-32), tribocharged backings (e.g., see page 6, lines 7-10), and electret backings (e.g., see page 6, lines 11-12). Articles according to the present invention removably cling to substrates, and can be activated at low temperature to provide an adhesive bond (e.g., see the specification on page 3, lines 25-26).

In view of the meaning of the term "cling backing", and the foregoing discussion, it is submitted that the Patent Office has not provided all elements (e.g., the cling backing) of claims 1, 29, and 53. For at least this reason, reconsideration and withdrawal of the rejection is requested. Claims 2-28, 30-52, and 54-64 add additional features to patentable claims 1, 29, and 53, respectively, and are likewise patentable.

In summary, the rejection of claims 1-64 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admissions in the specification at page 8, line 26 - page 9 line 2 concerning each of the three references Shiba et al., Lawton and WO 96/08540, the admissions taken in view of the remaining corresponding disclosure of each of the three references has been overcome and should be withdrawn.

Claims 1-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 19527789A1 laid-open/disclosure document in English.

The Patent Office asserts that the reference discloses (note particularly the Abstract, page 5, second complete paragraph, page 18, bottom paragraph bridging to page 19, first four lines, page 24, bottom paragraph, claims 1, 9 and 10) a broad genus of heat sensitive adhesive compositions coated on a broad genus of substrates such as a film wherein one of the major components, the thermoplastic resin, exhibits a gel content from 3 to 80%, which is believed to if not inherently anticipate the claimed adhesive presumably coated composition at least reduce to practice the claimed genus of cling articles through utilization of ordinary skill that page 24,

Application No.: 10/613,249Case No.: 58817US002

bottom paragraph teaches activation of the heat sensitive adhesive to 120°C, and as before the presence of a suitable method of adhering the cling article to a substrate as well as the article adhered to that substrate are each also believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

Without agreeing to the Patent Office's characterization of DE 19527789A1 laid-open/disclosure document in English, Applicants submit that the mere presence of a heat-activatable adhesive on a substrate is insufficient to achieve the invention of instant claims 1, 29, and 53. For example, it is unclear how DE 19527789A1 provides "a cling backing having first and second opposed major surfaces; and a heat-activatable adhesive in contact with at least a portion of the first major surface", for example, as in instant claims 1, 29, and 53.

The term "cling backing" is defined in the specification, for example, on page 5, lines 11-12 as "a backing that can cling to a substrate without the use of adhesives or fasteners. Examples of cling backings are described in the specification, for example, from page 5, line 21 through page 6, line 19. They include, for example, cling vinyl (e.g., see page 5, lines 30-32), tribocharged backings (e.g., see page 6, lines 7-10), and electret backings (e.g., see page 6, lines 11-12). Articles according to the present invention removably cling to substrates, and can be activated at low temperature to provide an adhesive bond (e.g., see the specification on page 3, lines 25-26).

In view of the meaning of the term "cling backing", and the foregoing discussion, it is submitted that the Patent Office has not provided all elements (e.g., the cling backing) of claims 1, 29, and 53. For at least this reason, reconsideration and withdrawal of the rejection is requested. Claims 2-28, 30-52, and 54-64 add additional features to patentable claims 1, 29, and 53, respectively, and are likewise patentable.

In summary, the rejection of claims 1-64 under 35 U.S.C. § 103(a) as being unpatentable over DE 19527789A1 laid-open/disclosure document in English has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Application No.: 10/613,249

Case No.: 58817US002

Respectfully submitted,

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Date

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